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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,236	07/03/2001	Sean Connolly	0111ZX-1	6077

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Kirschstein, Ottinger, Israel & Schiffmiller, P.C.
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EXAMINER

FRECH, KARL D

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,236

Applicant(s)

CONNOLLY ET AL.

Examiner

Karl D Frech

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2,5-6,8,13-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tremmel et al 4,418,277 in view of Moellering 3,826,900. Tremmel discloses an electro-optical scanner (wand reader 2) for reading indicia (bar code 1). The scanner has a transmitter unit (3). A system manager (processing unit 16, control unit 11). A signal is processed relating to the indicia (col 2 lines 48-49), and an acknowledgment signal is also processed when the indicia has been successfully read (col 2 lines 59-64) An indicator is provided on the hand held housing (col

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3 line 3-4) for presenting the acknowledgment signal (col 2 line 64 - col 3 line 5). This indicator is optical (light as claimed) or acoustic (speaker as claimed). Tremmel does not disclose that the wireless transmission means is RF. Moellering discloses a hand held scanner (30) which converts indicia information (coded data) into radio signals (col 2 lines 18-22). Moellering discloses in column 2 lines 23+, a light source (49) from which light is directed through an opening to an indicia. The reflected light is directed to a detector (56). It is disclosed that the operator scans (scribes) the prove across the indicia (col 2 lines 16-17). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to replace the infrared transmitter of Tremmel with the RF transmitter of Moellering. This would allow the system of Tremmel to be used in an environment (such as warehouses, retail facilities) in which physical obstacles would obstruct the infrared line of sight, but the RF transmission would not be obstructed as it is a physical characteristic of RF to be able to travel through obstacles such as walls, crates, shelving units, etc.

4. Claims 3,4,7,9,10-12,17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tremmel et al and Moellering as applied to claims 1,13 above, and further in view of well known prior art. Regarding claim 3 Tremmel and Moellering do not disclose the low power communications protocol. However, such low power communications protocols are well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use low power communications protocols in the combined invention of Tremmel and Moellering. This would help conserve power making the unit less expensive to

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operate as well as helping to reduce interference in external apparatus as required by FCC regulations. Regarding claim 4, Tremmel and Moellering do not disclose the look-up table being accessed. However, this is typical in retail establishments. For example, an acoustic "beep" is a signal in a grocery store when an item is moved passed a scanner when the item's price (held in a database) is located and added to the tally of a customer's bill. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the acknowledgment signal when an indicia's information is found in the database. This would indicate to the operator that not only has the raw data from the indicia is scanned properly, but also that the coded data held within the raw data from the indicia is associated with indicia that is actually relevant to that which is provided by the facility. Regarding claim 7, Tremmel and Moellering do not disclose that the indicator is remotely located from the scanner, expanding upon the grocery store example, the acoustic acknowledgment signal routinely comes from the terminal, not the scanner itself. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to locate the acoustic signal means remote from the hand held unit. This would allow the hand held scanning units to be replaced, interchanged without needing to replace the acoustic means. Regarding claim 9, Tremmel and Moellering do not disclose that the indicator is located on the clothing of the user. However, body wearable (clothing) bar code scanners are old and well known. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the combined invention of Tremmel and Moellering with a clothing wearable option in order to create a hands free ability

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for the user. Regarding claims 10-12,17-20, Tremmel and Moellering do not disclose that the acknowledgment signal is effective to signal that another action need be preformed. However, it is well known that this is what an acknowledgment signal is effectively used for. To expand upon the grocery store example, when the acknowledgment signal's acoustic "beep" is sounded, it is recognized by the operator of the system that a next action is to occur including moving the object to another location or destination (i.e. the grocery bag) or plurality of locations (i.e. separate grocery bags for meats, dry goods, produce, etc). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the acknowledgment signal as an indication to move onto a another operation or to move the item to a different location or locations. By doing so, it would effectively ensure proper scanning and processing of an item in a more efficient and speedy manner.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7,16-18 of U.S. Patent No. 5,543,610 in view of Tremmel et al, Moellering and well known prior art. Patent '610 claims recite an electro-optical scanner for scanning an indicia (bar code), with a light source and a detection means, and a processing means for generating a signal, and a transmission means which transmits in RF. Patent '610 does not recite the acknowledgment signal or indicator as currently claimed. However, as seen in the above 35 USC 103 rejection, Tremmel, Moellering and well known prior art disclose all the remaining currently claimed limitations. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the teachings of Tremmel, Moellering and well known prior art in the claimed invention of the '610 Patent. This would enable the indicia scanner of the '610 Patent to effectively communicate to the operator that a successful scan of the target indicia was achieved so that the operator could proceed to the next operation.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 5,099,110, 5,168,149, 5,191,197, 5,280,165, 5,124,539, 5,408,081,

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5,410,140, 5,614,706, 5,793,032, 6,010,071, 6,216,951, 6,145,746, 6,142,379, 6,053,413, 5,144,120 are all related to the current application.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl Frech whose telephone number is (703) 305-3491. The examiner's supervisor is Michael Lee whose telephone number is (703)305-3503. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703)308-0956. The Tech Center fax number is (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [karl.frech@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.



Karl D. Frech
Primary Examiner, AU 2876
May 02, 2003